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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JORMA J. LEHTOVAARA and MAREK FRANKOWSKI

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Appeal 2015-007910  
Application 13/778,588  
Patent 7,901,309 B2  
Technology Center 3600

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Before STEFAN STAICOVICI, KEN B. BARRETT,  
and CYNTHIA L. MURPHY, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jorma J. Lehtovaara and Marek Frankowski (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's rejection of claims 9, 12–16, and 18<sup>1</sup> in reissue application 13/778,588, filed February 27, 2013. The

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<sup>1</sup> After the filing of the Notice of Appeal, Appellants canceled claims 19–23 in an after-final amendment entered by the Examiner. *See* Advisory Action (1/12/15). There appears to be a disagreement as to the status of claims 1–8. *See* Appeal Br. 2 (Appellants asserting “[c]laims 1-8 are identical to the claims in issued U.S. Patent No. 7,901,309” and are pending); Final Rej. 1

reissue application seeks to reissue U.S. Patent 7,901,309 B2 (“the ’309 patent”), issued March 8, 2011, based on application 11/661,816, filed March 1, 2007. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

#### THE INVENTION

Appellants’ claimed invention pertains to a tensioner for a timing chain of an engine. The ’309 patent, col. 1, ll. 5–7. Claim 9, reproduced below with emphasis added, is the only independent claim on appeal and is illustrative of the subject matter on appeal.

9. A tensioner for tensioning an endless power transmission element on a motor vehicle engine, the tensioner comprising:

a base adapted to be fixed to the engine and defining a bore;

a pivot arm received in said bore and pivotally mounted to said base for rotation about a first axis;

a push rod assembly pivotally mounted to said pivot arm for rotation about a second axis extending parallel to said first axis;

a tensioning guide abutting said endless power transmission element, said tensioning guide adapted for pivotal mounting to said engine about a first pivot point and being pivotally connected to said push rod assembly about a second pivot point;

a spring biasing said pivot arm to move said push rod assembly and said tensioning guide in a direction tensioning said endless power transmission element;

wherein as said pivot arm moves in said tensioning direction, a push rod force line (F1) directed along said push

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(Examiner omitting claims 1–8 from the list of pending claims). Because those claims are not subject to a rejection, we do not reach the issue.

rod assembly shifts and tilts so that the length of a moment arm (R2), which is the orthogonal distance between said push rod action force line (F1) and said first pivot point, is greater at an end of travel of said pivot arm as compared to the length of said moment arm (R2) at a beginning of travel of said pivot arm; and

wherein said push rod assembly engages said pivot arm to generate friction forces between an outer surface of said pivot arm and an inner surface of said base, whereby motion of said pivot arm relative to said base in response to movement of said push rod assembly relative to said pivot arm is damped at least by said friction forces; and

*wherein said bore is unsealed such that an oil can flow into and out of said bore during operation of said tensioner, said oil not causing movement of the pivot arm relative to the base as said oil enters into or exits from said bore.*

Appeal Br. A-3–A-4 (Claims App.)

#### THE REJECTIONS

The following Examiner's rejections are before us for review:

1. Claims 9 and 12–16 are rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based;
2. Claims 9, 12–16, and 18 are rejected under 35 U.S.C. § 112(a) as failing to comply with the written description requirement;
3. Claims 9, 12–16, and 18 are rejected under 35 U.S.C. § 112(a) as failing to comply with the enablement requirement; and
4. Claims 9, 12–16, and 18 are rejected under 35 U.S.C. § 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor regards as the invention.

*REISSUE-RECAPTURE*

The Examiner rejected claims 9 and 12–16, maintaining that the omission from the claims of the tool slots through which a tool may be inserted to engage tooling features constitutes improper recapture of surrendered subject matter. Final Rej. 3–4, 8–9. Appellants argue that the claims, and specifically claim 9, “fall[] within the class of intermediate scope claims which escape the recapture rule under the third step of the [recapture] analysis.” Appeal Br. 8–9.

*Background*

At an early stage of the prosecution of the application that led to the issuance of the '309 patent, various claims (“the original claims”<sup>2</sup>) recited a tensioner having, *inter alia*, a base. See Amendment (3/31/09) 4–11 (e.g., claim 1 (“a base”), claim 4 (“said base [having] a cylindrical bore”), claims 18 and 30 (“a base that is adapted to be fixedly mounted to said engine”). The claims were rejected as anticipated or obvious in light of certain prior art references, including Wigsten. Non-Final Rej. (5/11/10) 9–21. In response, Applicants canceled all the pending claims and added new claims 35, 36, and 38–43. Amendment (8/11/10) 2–4. Added independent claim

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<sup>2</sup> In this decision, we refer to the claims as they stood before the pertinent amendment as the “original” claims. See *In re Youman*, 679 F.3d 1335, 1344 (Fed. Cir. 2012) (“when a patentee narrows the original claim in an effort to overcome a prior art rejection and makes arguments in support, the patentee surrenders the subject matter broader than the patented claim”); *id.* at 1343 (“The rationale underlying the rule is that the cancellation or amendment of the original claim in order to overcome prior art is a deliberate action . . .”).

35, which eventually issued as patented claim 1, contained further language regarding the base and recited:

A tensioner . . . comprising: . . .

a base defining a bore and a pair of tool slots, . . . the tool slots being formed through the base on a side opposite the front plate and intersecting the bore; . . .

wherein the first and second tooling features [of the pivot arm and push rod, respectively] can be aligned to the tool slots through rotation of the pivot arm relative to the base to permit a tool to be inserted through the tool slots and engaged to the first and second tooling features.

*Id.* at 2–3; *see also* the '309 patent, col. 9, ll. 2–28. In support of patentability, Applicants argued:

the newly presented claims are patentable over the several references cited in the above-referenced Office Action. For example, Wigsten et al. (US 2002/016068) [sic, US 2002/0160868] is a hydraulic tensioner and lacks tool slots through which a tool can be inserted to engage first and second tooling features in a pivot arm and a push rod. Applicant submits that formation of tool slots through the housing of Wigsten et al. would render that tensioner unsuitable for its intended purpose because it would leak hydraulic fluid.

*Id.* at 6. The Examiner allowed the claims and the '309 patent issued.

*Cf.* Supp. Notice of Allowability (12/10/10).

The reissue application that is the subject of the present appeal was filed subsequently. Independent reissue claim 9, submitted by a preliminary amendment, recites, in pertinent part:

9. A tensioner . . . comprising:

a base adapted to be fixed to the engine and defining a bore; . . .

wherein said bore is unsealed such that an oil can flow into and out of said bore during operation of said tensioner, said oil not causing movement of the pivot arm relative to the base as said oil enters into or exits from said bore.

Appeal Br. A-3–A-4 (claims appendix); *see also* Prelim. Amend. (3/27/13) 2–3. Reissue claim 9 does not recite “tool slots,” and does recite language directed to an unsealed bore.

### *Analysis*

“The recapture rule bars a patentee from recapturing subject matter, through reissue, that the patentee intentionally surrendered during the original prosecution in order to overcome prior art and obtain a valid patent.” *In re Youman*, 679 F.3d 1335, 1343 (Fed. Cir. 2012). The determination as to whether reissue claims violate the recapture rule involves a three-step analysis. *Id.* “Under the first step, we determine whether and in what aspect the reissue claims are broader than the patent claims.” *Id.* (internal quotations omitted). Under the second step, we “determine whether the broader aspects of the reissue claims relate to surrendered subject matter.” *Id.* (internal quotations omitted). If the reissue claims are broader relative to the patented claims in a manner related to surrendered subject matter, then under the third step, we “determine whether the surrendered subject matter has crept into the reissue claim.” *Id.* at 1344 (internal quotations omitted). Violation of the recapture rule under this third step may be avoided if “the [reissue] claims are materially narrowed in a way that avoids substantial or whole recapture of the surrendered subject matter.” *Id.* at 1344–1345. The materially narrowing analysis is conducted on a limitation-by-limitation basis and the frame of reference is the original claim—the claim prior to the surrendering amendment or cancelation. *Id.* at

1345, 1346; *see also id.* at 1347 (“[I]f the patentee modifies the added limitation such that it is broader than the patented claim yet still materially narrows relative to the original claim, the recapture rule does not bar reissue.”). “[A] limitation that is added during prosecution to overcome prior art cannot be entirely eliminated on reissue because doing so would constitute recapture of the surrendered subject matter.” *In re Mostafazadeh*, 643 F.3d 1353, 1359 (Fed. Cir. 2011).

There is no dispute that independent reissue claim 9 is broader than the patented claims because it omits the language found in issued claim 1 directed to the aspect of the tool slots. *See* Appeal Br. 7–9. There also is no dispute that the broader aspects relate to the tool slots. *Id.* at 8–9; *see also* Reply Br. 6 (Appellants arguing that “the re-issue claim retains, in broadened form, the limitation argued/added to overcome [an] art rejection.”). However, the Examiner and Appellants disagree as to what constitutes surrendered subject matter and the results of the third step of the analysis.

As to what constitutes surrendered subject matter, Appellants argue that the original claim covered both unsealed and sealed tensioners, that sealed tensioners could include those controlled by hydraulic pressure, and that the narrowing amendment added tooling holes thereby narrowing the claims to unsealed tensioners. Reply Br. 5; *see also* App. Br. 7 (maintaining that Applicants argued during prosecution that the added limitation regarding the tool slots and tool features was to distinguish the claimed invention over sealed hydraulic cylinders). Thus, argue Appellants, the narrowing amendment “exclude[ed] tensioners whose arm position can be

controlled by hydraulic pressure.” Reply Br. 5. In other words, Appellants’ position is that the applicants surrendered only subject matter directed to sealed tensioners and hydraulic tensioners. App. Br. 8–9.

The Examiner determines that the feature argued to overcome the art, and therefore relating to the surrendered subject matter, was the tool slots through which a tool could be inserted to engage first and second tooling features. Final Rej. 4, 8; Ans. 3. We agree with the Examiner.

“[T]o determine what the applicants surrendered, we look to the change of scope between the original [claim] and patented claim [] and the accompanying arguments applicants made during the original prosecution.” *In re Youman*, 679 F.3d at 1344. In this case, the pertinent amendment canceled, *inter alia*, original claim 1 which, in pertinent part, simply recited “a base”<sup>3</sup>, and added claim 35. Amendment (8/11/10), 2–3. Claim 35 (issued patent claim 1) more narrowly recited “a base defining a bore and a pair of tool slots” and further defined the location of the tool slots and identified their purpose (i.e. slots formed through the base on a side opposite the front plate, intersecting the bore, and located such that “the first and second tooling features can be aligned to the tool slots through rotation of the pivot arm relative to the base to permit a tool to be inserted through the tool slots and engaged to the first and second tooling features”), Amendment (8/11/10) 2–3. The accompanying arguments made by Applicants

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<sup>3</sup> Original claim 1: “A tensioner comprising: *a base*, a pivot arm . . . , a push rod assembly . . . wherein damping of motion of the pivot arm relative to the base . . . is at least substantially effected by said frictional forces.” Amendment (3/31/09), 4 (emphasis added, underlining and paragraphing omitted).

distinguished Wigsten on the basis that Wigsten “lacks tool slots through which a tool can be inserted to engage first and second tooling features in a pivot arm and a push rod.” Amendment (8/11/10) 6. While we recognize that Applicants stated that Wigsten is a hydraulic tensioner and argued that modifying the Wigsten embodiment to have tool slots would make it leak hydraulic fluid, *id.*, we are not persuaded that the surrendered subject matter merely was sealed tensioners generally or hydraulic tensioners specifically, as Appellants suggest. Similarly, we are not persuaded by the argument that the tool slots limitation was not added “for the purposes of enabling a tool to position the tensioner per se.” Reply Br. 4–5. The language added by amendment states explicitly, in the “wherein” clause, that the claimed tensioner is to be configured to allow a tool to engage the tooling features through the tool slots (Amendment (8/11/10) 2–3), and the Specification explains that this configuration is for purposes of preinstallation positioning of the tensioner arm (the ’309 patent, col. 4, l. 58–col. 5, l. 8).

We determine that the statements made in prosecution regarding leaking hydraulic fluid were directed to why one would not have modified Wigsten rather than as distinguishing the claimed invention over Wigsten on the basis of being unsealed. As discussed above, Applicants distinguished Wigsten on the basis of the tool slots. Thus, the Examiner is correct that the surrendered subject matter is any base broader than one having the tool slots limitations of the issued patent claims. Accordingly, the reissue claims, which lack the tool slot limitations, are broader relative to the patented claims in a manner related to surrendered subject matter.

We now turn to the third step of the analysis where we “determine whether the surrendered subject matter has crept into the reissue claim.” *In re Youman* at 1344 (internal quotations omitted). Appellants argue that reissue claim 9 is of intermediate scope (broader than the issued claims but narrower than “the claims originally filed with the application”) by virtue of the unsealed bore limitation. Appeal Br. 8–9. Particularly, Appellants contend that reissue claim 9 “include[es] a less specific limitation regarding the same feature surrendered – the tensioner being unsealed so that a position of the pivot arm relative to the base is not controlled by a fluid that acts on the pivot arm.” *Id.* at 8–9 (underlining omitted). Appellants argue that “this limitation” relates to the same feature (“i.e., slots through the base that would prevent the accumulation of hydraulic pressure”) that was relied upon to distinguish over the prior art and is materially narrower than the claims of the originally filed prior application. *Id.* at 9. The Examiner responds that the claims do not include a less specific limitation regarding the same feature that Appellants relied upon in distinguishing the prior art. Ans. 3. The Examiner determines that the “unsealed” aspect of reissue claim 9 is not directed to that same tool slots feature, and, therefore, Appellants have entirely eliminated the surrendered subject matter. Final Rej. 8–9; Ans. 4. The Examiner has the better position.

The issued patented claim 1 indicates that the bore and tool slots are two different structures. *See* the ’309 patent, col. 9, l. 7 (“a base defining a bore and a pair of tool slots”). In other words, the tool slots are structural features in addition to the bore. Further, the Specification indicates that tool slots are for a specific purpose and are “special features to help the initial

assembly of the tensioner in the production facility, as well as assist during the first installation of the tensioner on the engine and/or during the possible reinstallation in the field service.” The ’309 patent, col. 4, l. 58–col. 5, l. 2. This purpose is reflected in the “wherein” clause of the patented claim 1 which defines the relationship between the tooling features and the tool slots so that those components can be aligned. The limitation of claim 9 directed to the bore—specifically, “said bore is unsealed”—is not directed to the tool slots. The unsealed aspect of the bore does not define or limit the structure of tool slots because a base could lack tool slots entirely with the bore still unsealed in another manner. The rejected reissue claims lack the requirement of a pair of tool slots as recited in the issued patented claim 1, i.e. formed in the base and located such that tooling features can be aligned to the tool slots. Thus, the “tool slots” limitation added during prosecution has been eliminated in its entirety and the rejected reissue claims do not avoid recapture of surrendered subject matter.

We affirm the Examiner rejection of claims 9 and 12–16 as being an improper recapture of surrendered subject matter.

#### *WRITTEN DESCRIPTION*

Independent claim 9, and claims 12–16 and 18 which depend from claim 9, stand rejected as failing to comply with the written description requirement of Section 112. As mentioned above, claim 9 was added by preliminary amendment in the present reissue application. Claim 9 recites, *inter alia*, a base defining a bore, a pivotally mounted pivot arm, a pivotally mounted push rod, and “wherein said bore is unsealed such that an oil can flow into and out of said bore during operation of said tensioner, said oil not

causing movement of the pivot arm relative to the base as said oil enters into or exits from said bore.”

To comply with the written description requirement, the application must reasonably convey to one of ordinary skill in the art that the inventor had possession of the claimed subject matter. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (citations omitted). The bore of claim 9 is defined functionally, and therefore covers all bores that are configured to perform that function. In this case, the disclosure must reasonably convey possession of not only a tensioner having an unsealed bore, but a tensioner having a bore that is unsealed in a manner such that oil may flow into and out of the bore during operation and such that the oil would not cause movement of the pivot arm upon entering and exiting the bore.

The Examiner finds that the tensioner of Figure 7 is the only embodiment for which oil is discussed in the Specification, and that that embodiment lacks the recited pivot arm and push rod of claim 9. Final Rej. 5; *see* Ans. 4–5 (concluding that the claims are directed to, e.g., the embodiment of Figure 1 by virtue of the limitation directed to the pivotally mounted pivot arm). The Examiner further finds that the Specification does not discuss oil in the context of embodiments having push rods and pivot arms. *Id.* Specifically, the Examiner finds that “the original disclosure lacks support for the flow of oil into and out of said unsealed bore [of the claimed invention],” and finds that this constitutes new matter. Ans. 5. As such, the Examiner rejected claims 9, 12–16, and 18 for lack of written description.

Appellants argue that the pertinent feature has written description support, relying on two distinct embodiments along with the purported knowledge of a person of ordinary skill in the art. App. Br. 10–11; Reply Br. 6–7. Appellants begin with the assertion “that a person of ordinary skill in the art knows that a tensioner for the chain of an engine timing drive is bathed in oil when the engine operates.” App. Br. 10. Appellants assert that this fact is mentioned in regard to the embodiment of Figures 3 and 7<sup>4</sup>, which has a cup that may fill with oil during operation. *Id.* Appellants then turn to another embodiment, that of, e.g., Figure 1, having tool slots 18a and 18b and hole 61 in the base, and asserts that “a person of ordinary skill in the art would appreciate that the bore in the base was ‘unsealed.’” *Id.* Appellants then argue “given the fact that tensioners for the chain of a timing drive are bathed in oil during operation of the engine, a person of ordinary skill in the art would understand that engine oil would flow into and out of the bore in the base (via the slots 18a, 18b and hole 61) [of the Figure 1 embodiment].” *Id.*

Appellants’ entire argument is premised on the assertion that tensioners are bathed in oil, but we are not persuaded of the correctness of that argument. Appellants’ use of term “bathed” implies that persons of ordinary skill know that all timing chain tensioners are submersed in oil. *See* Reply Br. 6 (Appellants arguing that “[t]he ordinary automotive engineer knows that such a tensioner must be submersed in oil.”) The relied

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<sup>4</sup> As the Examiner correctly notes, the embodiment of Figures 3 and 7 cannot be an embodiment of claim 9 as it lacks the recited pivot arm feature. *See* Final Rej. 5; Ans. 4–5.

upon portion of the Specification, discussing the embodiment of Figures 3 and 7, does not support that proposition. The Specification refers to “fast flowing engine oil in the chain drive” and explains that oil will fill the cup 73 of the vertically mounted tensioner thereby supplying oil to the damping holes 82 and 83. *See* the ’309 patent, col. 7, ll. 1–5. Were the cylinder bathed in oil as Appellants suggest (as opposed to merely being exposed to oil flung from the chain), it seems that a cup to catch the oil would be unnecessary<sup>5</sup>. Appellants offer no other support for the correctness of the proposition that one would know chain tensioners are bathed in oil, and therefore this merely is attorney-argument and not evidence.

The embodiment of, for example, Figure 1 has a base with horizontally oriented tool slots 18a, 18b, and hole 61. *See* the ’309 patent, Fig. 1. This is in contrast to the other embodiment having an open cup facing upwards so as to catch oil for purposes of viscous damping. *See id.*, col. 7, ll. 1–10, Figs. 3, 7; *contra* Reply Br. 6 (Appellants arguing that there is no meaningful distinction between the different embodiments). We find that one of ordinary skill in the art would not recognize that the description of a base having horizontally oriented tool slots and holes discloses a bore that is configured such that oil can flow in and out and such that the oil will not cause movement of a pivot arm as oil flows in or out. Accordingly, we

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<sup>5</sup> The Specification also explains that, alternatively, the cup may be prefilled with engine oil. The ’309 patent, col. 7, ll. 1–2. If Appellants’ assertion that chain tensioners are bathed, or submersed, in oil is correct, we fail to see why there would be a need to prefill the cup with oil.

find that the application does not reasonably convey to one of ordinary skill in the art that the inventors had possession of the claimed subject matter of claim 9. Appellants do not offer separate arguments for the dependent claims that are the subject of this rejection. App. Br. 9–11. For these reasons, we affirm the Examiner’s rejection of claims 9, 12–16, and 18 as failing to comply with the written description requirement.

#### *ENABLEMENT*

Referring to the pivot arm, push rod, and oil claim language that is the subject of the written description rejection, the Examiner finds that claim 9 is not enabled by the original disclosure. For the basis of the rejection, the Examiner states “[s]ee the written description rejection above.” Final Rej. 6.

When rejecting a claim for lack of enablement, “the [United States Patent and Trademark Office] bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application ....” *In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993) (citing *In re Marzocchi*, 439 F.2d 220, 223-24 (CCPA 1971)). The test for compliance with the enablement requirement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). The “undue experimentation” analysis involves the consideration of several factors. *Wands*, 858 F.2d at 737.

The Examiner has not adequately addressed the *Wands* factors or otherwise explained why one of ordinary skill in the art would have to

engage in undue experimentation to practice the claimed invention.

Therefore, the Examiner has failed to establish non-enablement of claims 9, 12–16, and 18, and we are constrained to reverse the enablement rejection.

*INDEFINITENESS FOR FAILING TO PARTICULARLY POINT OUT AND  
DISTINCTLY CLAIM THE SUBJECT MATTER WHICH THE  
APPLICANTS REGARDS AS THE INVENTION*

In articulating the Section 112(b) rejection, the Examiner states:

Claim 9 and 20 are indefinite since the applicant did not particularly point out and distinctly claim an embodiment disclosed in the original disclosure. See the 112 first paragraph rejections above. Depending on how claim 9 or 20 is amended, a restriction may be necessary. A restriction is not currently presented, since it is unclear which embodiments the claims are drawn towards.

Final Rej. 7 (bolding omitted). The Examiner rejected the other claims subject to this ground as being dependent upon claims 9 or 20. *Id.* We cannot sustain the rejection.

The second paragraph of Section 112 contains two separate requirements: 1) to particularly claim that which the inventor regarded as the invention, and 2) to particularly point out and define the metes and bounds of the claimed subject matter. MPEP § 2171.

We understand the Examiner to maintain that the Specification lacks an embodiment corresponding to the claims and that, therefore, the applicants have not clearly identified that which they regard as the invention. However, “[a]greement, or lack thereof, between the claims and the specification is properly considered only with respect to the first paragraph of § 112; it is irrelevant to compliance with the second paragraph of that section.” *In re Ehrreich*, 590 F.2d 902, 906 (CCPA 1979). The subject

matter set out in the claim “must be presumed, in the absence of evidence to the contrary, to be that which the applicant regards as [the] invention.” *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971) (internal quotations omitted). The Examiner has not offered any persuasive evidence that the now-claimed invention is not what the applicants regard as their invention.

To the extent that the Examiner maintains that the claims fail to properly define the scope of the invention, the Examiner has not explained adequately what aspect is deemed to lack the requisite definiteness.

We reverse the rejection under 35 U.S.C. § 112(b) of claims 9, 12–16, and 18.

#### DECISION

The decision of the Examiner to reject claims 9, 12–16, and 18 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED